

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE - EXAMINING GROUP 1710

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PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#12 Response
9/10/02
(N.B.)

Applicants : Andrew Francis Kirby et al.
Application No. : 09/529,480
Filed : July 25, 2000
For : A METHOD FOR DISPERSING AN INSOLUBLE
MATERIAL IN AN AQUEOUS SOLUTION AND
AN AGRICULTURAL FORMULATION

Examiner : U. K. Rajguru
Art Unit : 1711
Docket No. : 470044.404USPC
Date : September 3, 2002

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Commissioner for Patents
Washington, DC 20231

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RESPONSE UNDER 37 C.F.R. § 1.116

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Commissioner for Patents:

In response to the Office Action mailed July 2, 2002 (Paper No. 11), Applicants hereby request that the finality of the pending Office Action be withdrawn on the basis that it is defective for lack of completeness and clarity pursuant to 37 CFR § 1.104(b) and MPEP § 707.07, and to allow Applicants the opportunity to fully and substantively respond to the Examiner's rejections and objections. Accordingly, Applicants further request that the defective Office Action be corrected and issued to Applicants with an extended period of time within which Applicants may substantively and fully respond thereto, as provided by MPEP § 710.06.

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37 CFR § 1.104(b) and MPEP § 707.07 provide, in relevant part, that: 1) the Examiner's action will be complete as to all matters, except as provided by the rules; 2) the ground of rejection of a claim must be fully and clearly stated and the statutory basis for the rejection expressly indicated; 3) the Examiner must address all arguments which have not already been responded to and must provide an explanation as to their non-persuasiveness; and 4) in response to Applicants' arguments that there is no suggestion to combine the references, the Examiner must explain where the motivation for the rejection is found, either in the references or in the knowledge generally available to those skilled in the art. The pending Office Action is defective under the rules for the reasons given below.

A. Defects Associated with Examiner's Objection to Applicants' Amendment Under 35 U.S.C. § 132

The Examiner objected to Applicants' Amendment filed April 8, 2002 (hereinafter, "Amendment") under 35 U.S.C. § 132 for allegedly introducing new matter into the disclosure via the "new" paragraph at page 14, line 4. However, the Examiner is not clear as to what the alleged new matter is that is being objected to. In fact, Applicants, in their Amendment, rewrote the paragraph beginning at page 14, line 4 to: 1) add " $\text{CH}_2\text{CO}_2\text{H}$ for R_2 "; 2) to add "the group" before $\text{O}=\text{S}$ and POR ; 3) to add " R_3 is hydrogen"; 4) to replace " H " with "hydrogen"; 5) to add "or" before SR_6 ; and 5) to replace SO_3R_4 with SO_3R_1 . The pending Office Action lacks completeness and clarity because it does not make clear which of these additions the Examiner regards as introducing new matter into the disclosure. Some of the additions? All of them? It is impossible, therefore, for Applicants' to substantively and fully respond to this objection.

B. Defects Associated with Examiner's Rejection of Claims 1, 9, 15-16, 18, 24-26, 33, 37-41, 46-48, 55 and 57 Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected the above claims under 35 U.S.C. § 112, First Paragraph on the basis that Applicants, in their Amendment, failed to point out the support in the specification for changing "cyclopentene" to "cyclopentane" in claim 1; for introducing the

proviso at the end of step (i) in claim 9; for introducing $\text{-CH}_2\text{CO}_2\text{H}$ – etc. in claim 15; and for making similar other changes in the remaining claims. Again, the pending Office Action lacks completeness and clarity by not making clear what changes the Examiner is referring to. Specifically, it is not clear what is meant by use of the term “etc.” above. Claim 15 was amended to incorporate a number of different changes. It is not clear which of these the Examiner is asserting as lacking in support. It is also unclear as to what is meant by “similar other changes in the remaining claims.” As only one of several examples, Applicants have no idea why the Examiner has maintained a 35 U.S.C. § 112, First Paragraph rejection of claims 24 and 46. Again, it is impossible for Applicants’ to substantively and fully respond to this rejection in view of this lack of completeness and clarity.

C. Defects Associated with Examiner’s Rejection of Claims 15, 16, 24, 25, 26, 27, 29, 32, 46, 47-49, 51-54 and 55 Under 35 U.S.C. § 112, Second Paragraph

In the pending Office Action, the Examiner maintained this rejection, previously set forth in the first Office Action of November 7, 2001, while only explaining that Applicants’ arguments against the rejection are not persuasive. Applicants, in their Amendment, set forth amendments and arguments that addressed every ground of the rejection presented by the Examiner in the first Office Action. The maintained rejection is not clear as to which grounds of rejection have been maintained and lacks clarity and completeness under the rules in not addressing Applicants’ pertinent arguments set forth in their Amendment, and in not providing an explanation as to their non-persuasiveness.

Specifically, this rejection, as presented in the first Office Action, alleged 10 grounds therefor: 1) claim 15 being vague for allegedly reciting Y as a carbon atom and also representing carbon by the letter “C”; 2) claim 15 being vague for representing hydrogen in the same formula by R_2 and R; 3) claim 15 being vague for allegedly reciting O as a sulfur atom or POR; 4) claim 15 being vague as the word “residue” was allegedly not clear; 5) claim 15 being vague because the meaning of “POR” was allegedly not clear; 6) claims 29, 32, and 51 being

vague in reciting “agriculturally acceptable salt”; 7) claim 55 being vague re the use of “1000 to 90,000 daltons”; 8) claims 24 and 26 being indefinite for using improper Markush terminology; 9) claims 25 and 26 being indefinite for reciting a group having only one member; and 10) claim 54 being indefinite for reciting “derivatives” in lines 21 and 22. Also, the rejection asserted, in connection with the above grounds of rejection of claim 15, that similar comments applied to claims 16, 25, 26, 47 and 48.

First, it is not clear what the Examiner meant in noting, in connection with the grounds of rejection of claim 15, that similar comments applied to claims 16, 25, 26, 47 and 48. This is particularly unclear in view of the fact that, for example, claims 15 and 16 are very different, are not analogous, and do not recite the same elements to which the grounds of rejection of claim 15 were directed. So, it is not clear what grounds are being asserted by the Examiner for this maintained rejection.

Also, it is not at all clear which of the above-listed 10 grounds of rejection the Examiner is maintaining. Applicants find it unlikely that the Examiner is maintaining all of the grounds. For example, the Examiner rejected claim 15 as vague for reciting the word “residue,” whose meaning the Examiner found unclear. In the Amendment, Applicants replaced the word “residue” with the word “cation.” As another example, the Examiner rejected, in the first Office Action, claims 24 and 26 as indefinite for reciting improper Markush terminology. However, Applicants amended claims 24 and 26 to correct the terminology. Yet, the Examiner has evidently maintained the rejection of claims 24 and 26 without explanation.

Additionally, the Examiner, with the possible exception of only one out of the above-listed 10 grounds (designation of molecular weight in claim 55), has not addressed Applicants’ pertinent amendments and/or arguments, nor explained why the same were not found to be persuasive, as required by the rules. This lack of completeness and clarity, and failure to address Applicants’ arguments or explain why they were found to be unpersuasive, has made it impossible for Applicants to substantively and fully respond to the pending Office Action with regard to this maintained rejection.

D. Defects Associated with Examiner's Rejection of Claims 9-57 Under 35 U.S.C. § 103(a)

In the first Office Action, the Examiner rejected claims 9-57 under 35 U.S.C. § 103(a) as being unpatentable over JP 58131903 to Kataoka et al. in view of JP 62-36302 to Fujita et al. In their Amendment, Applicants presented arguments as to why the Examiner had not established a *prima facie* case of obviousness in combining the references, namely, that there is no teaching, suggestion, or motivation, found either in the references or in the knowledge generally available to one of ordinary skill in the art, to combine the references; and that the references do not teach or suggest all of the limitations of the rejected claims. In the pending Office Action, the Examiner has maintained the rejection, only noting that Applicants' arguments were found unpersuasive because there is a motivation to combine the references, as originally presented by the Examiner. However, the Examiner has failed to identify where such alleged motivation appears in the cited references.

Again, the pending Office Action's lack of completeness and clarity, and failure to address Applicants' arguments or explain why they were found to be unpersuasive, make it impossible for Applicants to substantively and fully respond to the pending Office Action with regard to this rejection.

In view of the above remarks, Applicants respectfully request that the finality of the pending Office Action be withdrawn, that the above-described defects be corrected, and that Applicants be given an extended period of time within which to substantively and fully respond to the corrected Office Action, as provided by MPEP § 710.06. Alternatively, Applicants respectfully request a telephone interview to address these matters in more detail. To that end,

the undersigned attorney can be reached at 206-694-4821 between the hours of 8:30 am and 6:00 pm, Pacific Standard Time.

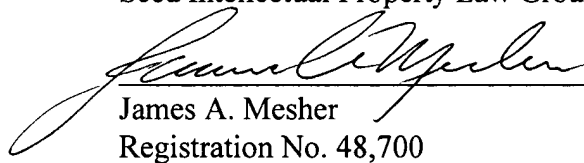


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Respectfully submitted,

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